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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,580	10/03/2000	Daniel A. Japuntich	48317USA7K.030	7366

7590 01/02/2002

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EXAMINER

LEWIS, AARON J

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 01/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/678,580

Applicant(s)  
DANIEL A. JAPUNTICH ET AL.

Examiner  
AARON J. LEWIS

Art Unit  
3761



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 15, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 33-58 and 60-67 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-58 and 60-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

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## **DETAILED ACTION**

### ***Double Patenting***

1. Claims 33-58,60-67 of this application conflict with claims 34-77 of Application No. 08/240,877; 34-77 of 09/440,619; 33-71 of 09/678,579; 33-54,56-61 of 09/678,488; 33-54,56 of 09/677,637; 33-36,38-62,64-66 of 09/677,636. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 33-36,50-56,58,60,61-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al.('516) in view of French patent (1,209,475), for the reasons set forth on pages 3-7 of the Office action dated 07/05/2001.

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As to claim 61, French patent ('475) illustrates an opening that is disposed directly in the path of fluid flow when the free portion of the flexible flap is lifted from the seal during an exhalation (figs. 3 and 4).

As to claim 62, the valve cover of French patent ('475) is illustrated in figs. 3 and 4 as being approximately parallel to the path traced by the second end of the flexible flap (14) during its opening and closing.

As to claim 63, Simpson et al. as further modified by French patent ('475) teach a cover which is fully capable of performing the recited function of directing exhaled air downwards when the mask is worn by a person (also see fig. 1 of Simpson et al.).

As to claim 64, the cover of French patent '475 (figs. 3 and 4) illustrates fluid impermeable sidewalls.

As to claim 65, the opening in the cover of French patent ('475) is at least the size of the orifice in the valve seat as illustrated in figs. 3 and 4.

Claim 66 is substantially equivalent in scope to claim 33 and is included in Simpson et al. as modified by French patent ('475) for the reasons set forth above with respect to claim 33.

As to claim 67, the valve cover of Simpson et al. as modified by French patent ('475) is secured to the valve seat by a bolt (11,34). It would have been obvious to modify the means of attachment to substitute any well known means including one which is a friction fit as an obvious matter of design choice with no new or unobvious results accruing. The substitution of a friction

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fit arrangement would allow for quick and relatively easier disassembly as compared to that of a bolt which requires tools.

4. Claims 37-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of French patent (1,209,475) as applied to claims 33-36, 50-56, 58, 60-65 above, and further in view of McKim ('618), for the reasons set forth on pages 7-8 of the Office action dated 07/05/2001.

***Response to Arguments***

5. Applicant's arguments filed 10/15/2001 have been fully considered but they are not persuasive.

In response to applicant's argument that French patent (1,209,475) is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it is submitted that one of ordinary skill would look to the art of valves (which includes French patent ('475)) to address problems associated with protecting the valve element from debris and/or damage and for controlling the direction of flow of fluid through a valve using a cover for such a valve.

As to applicant's arguments regarding the propriety of the combination of prior art to Simpson et al. and French patent ('475), it would have been obvious to modify the valve of Simpson et al.

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to employ a cover because it would have provided protection for the exhalation valve and because it would have provided a means for accessing the valve for cleaning and/or replacement as taught by French patent ('475), as set forth on page 4 of the Office action dated 07/05/2001.

***Conclusion***

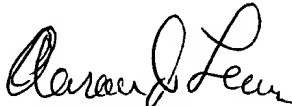
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Lewis whose telephone number is (703) 308-0716.

Aaron J. Lewis

December 30, 2001

  
Aaron J. Lewis  
Primary Examiner